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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,258	04/12/2001	Carlos De La Huerga	250591.90295	3649
26710	7590	12/03/2004	EXAMINER PHAN, THANH S	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			ART UNIT 2841	PAPER NUMBER

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,258

Applicant(s)

DELAHUERGA, CARLOS

Examiner

Thanh S Phan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-163 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-163 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, drawn to configuring an indicating configuration for a container, classified in class 40, subclass 311.
- II. Claims 35-41, drawn to medication containers with alert means, classified in class 116, subclass 4.
- III. Claims 42-45, drawn to a medical database, classified in class 705, subclass 2.
- IV. Claims 46-47, drawn to an indicator for a container, classified in class 116, subclass 200.
- V. Claims 48-52, drawn to means to identify, classified in class 283, subclass 81.
- VI. Claims 53-70, drawn to prescription system, classified in class 705, subclass 3.
- VII. Claims 71-91, drawn to a method to configure an indicating configuration, classified in class 283, subclass 71.
- VIII. Claims 92-96, drawn to a method to provide medication, classified in class 221, subclass 289.
- IX. Claim 97, drawn to method for configuring indicating data for containers, classified in class 283, subclass 81.

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- X. Claims 98-99, drawn to a method of storing product information based on configuration, classified in class 700, subclass 231.
- XI. Claims 100-105, drawn to medication prescription system, classified in class 116, subclass 3.
- XII. Claims 106-107, drawn to apparatus for providing container labels, classified in class 705, subclass 2.
- XIII. Claims 108-111, drawn to a method to attach labels to containers, classified in class 156, subclass 215.
- XIV. Claims 112-129, drawn to method of updating labels, classified in class 283, subclass 900.
- XV. Claims 130-150, drawn to reading means for labels, classified in class 356, subclass 300.
- XVI. Claims 151-155, drawn to method of filling orders, classified in class 53, subclass 45.
- XVII. Claim 156, drawn to a method of encoding recipients, classified in class 700, subclass 235.
- XVIII. Claims 157-158, drawn to method of identify containers for storage, classified in class 705, subclass 2.
- XIX. Claim 159, drawn to a method of processing data, classified in class 710, subclass 1.
- XX. Claim 160, drawn to a method of storing information, classified in class 705, subclass 2.

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XXI. Claim 161, drawn to indicia for containers, classified in class 283, subclass 900.

XXII. Claim 162, drawn to storing data within memory, classified in class 235, subclass 425.

XXIII. Claim 163, drawn to a method of preparing prescriptions, classified in class 700, subclass 237.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXII and XXIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a configuring an indicating configuration for a container not using the medication containers of II, the specific database of III, the specific indicator of IV, the specific means to identify of V, the prescription system of VI, the indicating configuration of VII, the method to provide medication of VIII, the method of configuring data for containers of IX, the method of storing product information of X, the prescription system of XI, the method of providing labels of XII, the method of attaching labels of XIII, the updating method of XVI, the method of encoding recipients of XVII, the data processing of XIX, the information storage method of XX, the indicia for containers of XXI, the data storage method of XXII and the prescription preparation method of XXIII, invention II has separate utility such as a medication container not using the specific means of claims I and III-XXIII, invention III has separate utility such as a medical data base not using the specific means of I-II and IV-XXIII, invention IV

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has separate utility such as a indicator for a container not using the specific means of I-III and V-XXIII, invention V has separate utility such as means to identify not using the specific means of I-IV and VI-XXIII, invention VI has separate utility such as a prescription system not using the specific means of I-V and VII-XXIII, invention VII has separate utility such as a method to configure an indicating configuration not using the specific means of I-VI and VIII-XXIII, invention VIII has separate utility such as a method to provide medication not using the specific means of I-VII and IX-XXIII, invention IX has separate utility such as a method for configuring indicating data for containers not using the specific means of I-VIII and X-XXIII, invention X has separate utility such as a method of storing product information based on configuration not using the specific means of I-IX and XI-XXIII, invention XI has separate utility such as a medication prescription system not using the specific means of I-X and XII-XXIII, invention XII has separate utility such as an apparatus for providing container labels not using the specific means of I-XI and XIII-XXIII, invention XIII has separate utility such as a method to attach labels to containers not using the specific means of I-XII and XIV-XXIII, invention XIV has separate utility such as a method to update labels not using the specific means of I-XIII and XV-XXIII, invention XV has separate utility such as a reading means for labels not using the specific means of I-XIV and XVI-XXIII, invention XVI has separate utility such as a method of filling orders not using the specific means of I-XV and XVII-XXIII, invention XVII has separate utility such as a method of encoding recipients not using the specific means of I-XVI and XVIII-XXIII, invention XVIII has separate

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utility such as a method to identify containers for storage not using the specific means of I-XVII and XIX-XXIII, invention XIX has separate utility such as a method of processing data not using the specific means of I-XVIII and XX-XXIII, invention XX has separate utility such as a method of storing information not using the specific means of I-XIX and XXI-XXIII, invention XXI has separate utility such as indicia for containers not using the specific means of I-XX and XXII-XXIII, invention XXII has separate utility such as a data storage method not using the specific means of I-XXI and XXIII, invention XXIII has separate utility such as a method of preparing prescriptions not using the specific means of I-XXII. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- Embodiment 1: figure 1;
- Embodiment 2: figure 2;
- Embodiment 3: figure 5;
- Embodiment 4: figure 6
- Embodiment 5: figure 7;
- Embodiment 6: figure 8;
- Embodiment 7: figure 9;
- Embodiment 8: figure 10;

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Embodiment 9: figure 11;

Embodiment 10: figure 12;

Embodiment 11: figure 13;

Embodiment 12: figure 14;

Embodiment 13: figure 15;

Embodiment 14: figure 16;

Embodiment 15: figure 17;

Embodiment 16: figure 18;

Embodiment 17: figure 19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).



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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S Phan whose telephone number is 571-272-2109. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tsp



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